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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
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29623/108

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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BARALTA, HEATHER

DATE MAILED: 1998

11/13/98

VINSON & ELKINS  
1455 PENNSYLVANIA AVENUE NW  
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WASHINGTON DC 20004-1008

This is in response to the Power of Attorney filed 10/

- ☐ 1. The Power of Attorney to you in this application has been ~~revoked~~ by the applicant. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.
- ☒ 2. The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record. (37 CFR 1.33)
- ☐ 3. The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

*[Signature]*  
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- ☒ 4. The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the below-noted address as provided by 37 CFR 1.33.
- ☐ 5. The Power of Attorney in this application is not accepted for the reason(s) checked below:
- ☐ a. The Power of Attorney is from an assignee and the Certificate required by 37 CFR 3.73 (b) has not been received.
- ☐ b. The person signing for the assignee has omitted their empowerment to sign on behalf of the assignee.
- ☐ c. The inventor(s) is without authority to appoint attorneys since the assignee has intervened as provided by 37 CFR 3.71.
- ☐ d. The signature of \_\_\_\_\_, a co-inventor in this application, has been omitted. The Power of Attorney will be entered upon receipt of confirmation signed by said co-inventor.
- ☐ e. The person(s) appointed in the Power of Attorney is not registered to practice before the U. S. Patent & Trademark Office.
- ☐ f. The revocation is not signed by the applicant, the assignee of the entire interest, or one particular principal attorney having the authority to revoke.

POLEY & LORINGER  
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*[Signature]*  
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Art Unit: 1818

### DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16, drawn to a microfabricated device, classified for example in class 435, subclass 287.
  - II. Claims 17-20, drawn to a method of using a device for identification and characterization of biomolecules, classified for example in class 435, subclass 4.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the device product may be used for separation of biomolecules.
4. These inventions are distinct for the reason given above and have acquired a separate status in the art because of their recognized divergent subject matter as evidenced by their different classification. In addition, prior art searches require non-patent literature searches. The literature search for the invention of Group I would not be expected to reveal all the relevant references for the invention of Group II, and vice versa. Therefore, restriction for examination purposes as indicated is proper.
5. Claim 2 is generic to a plurality of disclosed patentably distinct species comprising:

Art Unit: 1818

- i. Claims 10-11, polynucleotides fixed by attachment of a terminal primary amine derivative to glass
- ii. Claim 12, polynucleotides fixed by attachment of a terminal bromoacetyl derivative to platinum

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. A telephone call was made to Michael Sanzo on 30 October 1996 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Any inquiry concerning this communication should be directed to Heather Bakalyar at telephone number (703)305-7143.

The examiner can normally be reached on Monday through Friday from 9:00 am to 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Serial Number: 08/631,751

Page 4

Art Unit: 1818

Donald E. Adams, Ph.D., can be reached on (703) 308-0570. The fax phone number for this Group is (703)305-7939.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1800 receptionist whose telephone number is (703)308-0196.

Heather Bakalyar, Ph.D.

11/19/96

*DE Adams*  
**DONALD E. ADAMS**  
**SUPERVISORY PATENT EXAMINER**  
**GROUP 1800**